

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Markus DILLINGER et al.

Serial No. 10/525,995

Group Art Unit: 2617

Confirmation No. 2832

Filed: February 28, 2005

Examiner: Kwasi Karikari

For: TERMINAL DEVICE, RADIO COMMUNICATION SYSTEM AND CONFIRMATION UNIT
FOR RADIO COMMUNICATION SYSTEM (as amended)

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

The following comprises the Appellants' Brief on Appeal from the final rejection, dated March 8, 2007, of claims 14-26. This Appeal Brief is accompanied by the required appeal fee set forth in 37 C.F.R. § 41.20(b)(2). Appellants' Notice of Appeal was filed on April 16, 2007. Therefore, the present Appeal Brief is timely filed.

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I. REAL PARTY IN INTEREST

The above-captioned application is assigned in its entirety to SIEMENS AKTIENGESELLSCHAFT, having a corporate situs of Wittelsbacherplatz 2, D-80333 Munich, Germany.

II. RELATED APPEALS AND INTERFERENCES

Appellants state that, upon information and belief, Appellants are not aware of any co-pending appeal or interference that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 14-26 are pending in the application. Claims 1-13 were cancelled. Claims 14-26 were rejected. The rejection of claims 14-26 is being appealed.

IV. STATUS OF AMENDMENTS

One amendment was filed subsequent to the final rejection on April 16, 2007. The amendment addressed the Objection to the Specification in section 3, at page 4 of the final Office Action mailed March 8, 2007, in order to place the application in better condition for Appeal. No claims were amended.

The Examiner responded to the amendment in an Advisory Action mailed May 22, 2007, saying that:

The applicant refused to respond to items in the Final Office Action. An appropriate and completed response is required.

V. SUMMARY OF CLAIMED SUBJECT MATTER

1. Independent claim 14:

Independent claim 14 is directed to a method for operating a terminal device MS in a radio communication system WLAN, GSM, as shown in Fig. 1 and described at page 6, lines 21-29. The method may include sending a confirmation SZ from a confirmation unit CU confirming that the terminal device MS will be checked for proper functional integrity during operation, as shown in Fig. 2, and described at page 3, lines 4-10 and at page 8, lines 13-21. The terminal device MS may be checked for proper functional integrity by checking signals S to be transferred via the terminal device MS for compliance with a least one quality criterion, as shown in Fig. 2, and described at page 5, lines 13-16 and page 8, lines 25, 26, and 27. The method may include authorizing operation of the terminal device MS in the radio communication system WLAN, GSM only upon the terminal device MS having received the confirmation SZ, as shown in Fig. 2, and described at page 2, lines 8-11 and page 8, lines 18-24.

2. Independent claim 24:

Independent claim 24 is directed to a radio communication system WLAN, GSM, as shown in Fig. 1 and described at page 6, lines 21-29. The radio communication system WLAN, GSM may include a confirmation unit CU, as shown in Fig. 1 and described at page 7, lines 3 and 4. The confirmation unit CU may include a signal generation device SP, SP' generating a confirmation signal SZ, as shown in Fig. 1 and described at page 7, lines 4-12. The confirmation unit CU may also include a transmit device AP, BS sending the confirmation signal SZ, as shown in Fig. 1 and described at page 8, lines 18-21. The radio communication system WLAN, GSM may include a terminal device MS, as shown in Fig. 1 and described at page 6, lines 21-29. The terminal device MS may include a receive device MSRX receiving the confirmation signal SZ indicating that the terminal device MS will be checked for proper functional integrity during operation, as shown in Fig. 4 and described at page 3, lines 4-10 and at page 9, lines 1, 2, 3, and 16-19. The terminal device MS may also include a deactivation unit DA only permitting further operation of the terminal device MS if the receive device has received the confirmation signal SZ, as shown in Fig. 4, and described at page 9, lines 6-10, 16, 17, and 18.

3. Independent claim 25:

Independent claim 25 is directed to a terminal device MS for a radio communication system WLAN, GSM, as shown in Fig. 1 and described at page 6, lines 21-29. The radio

communication system WLAN, GSM may have a confirmation unit CU, as shown in Fig. 1 and described at page 7, lines 3 and 4. The terminal device MS may include a receive device MSRX receiving a confirmation signal SZ from the confirmation unit CU of the communication system WLAN, GSM, as shown in Fig. 4 and described at page 9, lines 1, 2, 3, and 16-19. The confirmation signal SZ may indicate that the terminal device MS will be checked for proper functional integrity during operation in the communication system WLAN, GSM, as shown in Fig. 2, and described at page 3, lines 4-10 and at page 8, lines 13-21. The terminal device MS may also include a deactivation device DA only permitting further operation of the terminal device MS if the receive device MSRX has received the confirmation signal SZ, as shown in Fig. 4, and described at page 9, lines 6-10, 16, 17, and 18.

4. Independent claim 26:

Independent claim 26 is directed to a confirmation unit CU for a radio communication system WLAN, GSM, as shown in Fig. 1 and described at page 7, lines 3 and 4. The radio communication system WLAN, GSM may have at least one terminal device MS, as shown in Fig. 1 and described at page 6, lines 21-29. The confirmation unit CP may include a device SP, SP' generating a confirmation signal SZ, as shown in Fig. 1 and described at page 7, lines 4-12. It may be inferred from the confirmation signal SZ that the at least one terminal device MS will be checked for proper functional integrity during operation in the communication system WLAN, GSM, as shown in Fig. 2, and described at page 3, lines 4-10 and at page 8, lines 13-21. The confirmation unit CP may also include a transmit device AP, BS sending the confirmation signal SZ to the terminal device MS, as shown in Fig. 1 and described at page 8, lines 18-21.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed in this Appeal:

1. The rejection of claims 14-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
2. The rejection of claims 14, 24, 25, and 26 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0002462 to Tanoue (hereinafter "Tanoue").
3. The rejection of claims 15 and 16 under 35 U.S.C. § 103(a) as unpatentable over Tanoue in view of U.S. Patent No. 6,760,444 to Leung (hereinafter "Leung").
4. The rejection of claim 17 under 35 U.S.C. § 103(a) as unpatentable over Tanoue and Leung in view of U.S. Patent Application Publication No. 2004/0029576 to Flykt et al. (hereinafter "Flykt").
5. The rejection of claims 18 and 19 under 35 U.S.C. § 103(a) as unpatentable over Tanoue, Leung and Flykt in view of U.S. Patent No. 6,170,006 to Namba (hereinafter "Namba").
6. The rejection of claims 20-23 under 35 U.S.C. § 103(a) as unpatentable over Tanoue, Leung, Flykt, and Namba in view of U.S. Patent Application Publication No. 2003/0236991 to Letsinger (hereinafter "Letsinger").

VII. ARGUMENTS

1. The subject matter of claims 14-26 is enabled within the meaning of 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 112, first paragraph, provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112, first paragraph is thus directed, in particular, to the *specification*. As noted by the Examiner in section 5 of the final Office Action mailed March 8, 2007, at page 5, line 21:

The specification mentions a specific invention steps 1-10 in Fig. 2.

Since, as acknowledged by the Examiner, the specification, and in particular Fig. 2 of the specification, describes an embodiment of the invention, the specification is submitted to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.

The Examiner goes on to assert, in section 5 of the final Office Action mailed March 8, 2007, at page 5, lines 21, 22, and 23, continuing at page 6, line 1:

However, Claim 1 specifically is written in such a way which is not clear and also different from the applicants invention step in Fig. 2 to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 14, to the contrary, is enabled by the specification. Independent claim 14, in particular, is directed to a method for operating a terminal device MS in a radio communication system WLAN, GSM, as shown in Fig. 1 and described at page 6, lines 21-29. The method of independent claim 14 may include sending a confirmation SZ from a confirmation unit CU confirming that the terminal device MS will be checked for proper functional integrity during operation, as shown in Fig. 2, and described at page 3, lines 4-10 and at page 8, lines 13-21. The terminal device MS may be checked for proper functional integrity by checking signals S to be transferred via the terminal device MS for compliance with a least one quality criterion, as shown in Fig. 2, and described at page 5, lines 13-16 and page 8, lines 25, 26, and 27. The

method may include authorizing operation of the terminal device MS in the radio communication system WLAN, GSM only upon the terminal device MS having received the confirmation SZ, as shown in Fig. 2, and described at page 2, lines 8-11 and page 8, lines 18-24. Claim 14 is thus submitted to be clear, and enabled by the specification, within the meaning of 35 U.S.C. § 112, first paragraph.

The Examiner asserts further in section 5 of the final Office Action mailed March 8, 2007, at page 6, lines 1-4, that:

For example, claim 14 do not show where the confirmation message is sent to; and claim 14 does not indicate any initial communication between the confirmation unit and the terminal device.

The third clause of claim 14, to the contrary, recites:

Said terminal device having received said confirmation.

35 U.S.C. § 112, first paragraph, moreover, applies to the specification, as discussed above. The confirmation message, i.e. signal, for example, is described at several places in the specification. In one embodiment, the confirmation signal is transferred to the terminal device. In particular, as described at paragraph [0008]:

In accordance with a development of the invention, a confirmation signal is provided which, in the event of its being transferred to the terminal device, specifies that the terminal device will be checked while it is operating.

In one embodiment, the confirmation signal may be the initial communication between the confirmation unit and the terminal device. In another embodiment, the terminal device may send a request to signal to the confirmation unit, whereupon the confirmation unit sends the confirmation signal to the terminal device. Paragraph [0009], for example, describes an embodiment in which the confirmation unit sends the confirmation signal to the terminal device in response to a request signal:

In accordance with a development of the invention, prior to its authorization for operation in the communication system the terminal device sends a request signal to a confirmation unit, whereupon the confirmation unit initiates the checking of the terminal device and sends the confirmation signal to the terminal device.

Paragraph [0011], similarly, describes an embodiment in which an appropriate service provider sends the confirmation signal to the terminal device:

The latter can, through use of the relevant address of the confirmation unit, also advantageously be forwarded in a network with a decentralized organization

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specifically to an appropriate service provider that initiates the desired check and sends the confirmation signal to the terminal device.

Paragraph [0023], similarly, describes an embodiment in which the checking center SC sends a confirmation signal to the network access station AP; BS, which passes on the confirmation signal SZ to the terminal device MS:

In a fifth step, the checking devices SP selected by the checking center SC sends a confirmation signal to the network access station AP; BS which in a sixth step passes on the confirmation signal SZ (cf. Figure 1) to the terminal device MS.

Claim 14 is thus submitted to be clear, and supported by the specification, within the meaning of 35 U.S.C. § 112, first paragraph.

The Examiner asserts in section 2a at page 2 of the final Office Action mailed March 8, 2007, that:

First of all, of the Applicant fails to clearly comply with the enablement requirements in claims 14, in such a way as to enable one skilled in the art to make and/or use the invention.

This is submitted to be without basis. Claim 14 is submitted to be enabled within the meaning of 35 U.S.C. § 112, first paragraph, as discussed above.

A specification, furthermore, need only enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention, as discussed above. Thus, a specification need not provide a background tutorial to enable *anyone* to make and use the claimed invention, but rather only those persons who are *skilled* in the art. A person skilled in the art, furthermore, is presumed to already *possess* the necessary background information. In particular, as provided in M.P.E.P. § 2164.01:

A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Since the confirmation signal is shown and described in the specification so as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, claims 14-26 are enabled within the meaning of 35 U.S.C. § 112, first paragraph.

Finally, there is no evidence of record to show that the Examiner based his conclusion

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that the subject matter of claims 14-26 is not enabled within the meaning of 35 U.S.C. § 112, first paragraph on the Undue Experimentation Factors required by M.P.E.P. § 2164.01(a). In particular, as provided in M.P.E.P. § 2164.01(a):

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

As provided further in M.P.E.P. § 2164.01(a):

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *In re Wands* 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

Since there is no evidence of record that the Examiner considered all the evidence related to each of the Undue Experimentation Factors, the Examiner's conclusion that the disclosure is not enabling is improper, *In re Wands*. The Examiner has therefore failed to make out a prima facie case of lack of enablement with respect to claims 14-26. Appellants, therefore, respectfully request that the rejection of claims 14-26 under 35 U.S.C. § 112, first paragraph be withdrawn.

2. Claims 14, 24, 25, and 26 are not anticipated by Tanoue.

A. Independent claim 14:

I. The second clause of independent claim 14:

Independent claim 14 is not anticipated by Tanoue because Tanoue fails to disclose all of the features of independent claim 14. Tanoue, for example, discloses no "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," as recited in the second clause of independent claim 14. The terminal device of Tanoue, rather, simply commences operation. The responsibility of setting a permissible range of transmission power to be transmitted to the

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mobile device UE at the time of starting communication falls on the base station controller RNC in Tanoue. Setting the permissible range of transmission power is not a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0027]:

At the time of starting communication between the mobile device UE and the base station controller RNC, the base station controller RNC sets to the base station the permissible range of transmission power (the maximum transmission power, the minimum transmission power) to be transmitted to the mobile device UE.

Since, in Tanoue, the base station controller RNC only sets the permissible range of transmission power to be transmitted to the mobile device UE at the time of starting communication, Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," as recited an independent claim 14.

Additionally, in Tanoue, the base station controller RNC only searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB. Searching whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0040]:

The base station controller RNC upon receiving the access request message 51 searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB based on the mobile device search information contained in the access request message 51 from the mobile device UE.

Since, in Tanoue, the base station controller RNC searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB, Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," as recited an independent claim 14.

Furthermore, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by one rank from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0043]:

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As the desired quality class set for the mobile device UE, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE, Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," as recited an independent claim 14.

Furthermore, in Tanoue, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by two ranks from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0045]:

As the desired quality class set for the mobile device UE, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE, Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," as recited an independent claim 14.

Finally, in Tanoue, an access request from the mobile device UE is rejected. Rejecting an access request from the mobile device UE is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0047]:

An access request from the mobile device UE is rejected. That is, an access request rejection message is transmitted to the mobile device UE.

Since, in Tanoue, an access request from the mobile device UE is rejected, Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," as recited an independent claim 14.

The Examiner asserts in section 2a at page 2 of the final Office Action mailed March 8, 2007, that:

However, in a broader understanding and application of applicants invention, Tanoue teaches such preceding claimed limitations (see Tanoue; paragraph 0008 oh).

This is submitted to be without basis. Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," at all, as discussed above. The terminal device of Tanoue, rather, simply commences operation. A faulty mobile device detection unit judges whether or not the mobile device is faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time. In particular, as described at paragraph [0008]:

The base station controller comprises a faulty mobile device detection unit for judging whether or not the mobile device is faulty based on the fact that the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, a faulty device registration request unit for supplying a faulty device registration request to the mobile device managing database to register a mobile device judged as faulty, and a desired receiving quality change instruction unit for giving an instruction to degrade a desired receiving quality class of a mobile device or for supplying a message to reject an access request to the mobile device in the case where, upon receiving the access request from the mobile device, the mobile device is found to be registered as faulty after searching the mobile terminal managing database.

Since, in Tanoue, a mobile device is judged to be faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," as recited in independent claim 14.

Accordingly, because Tanoue fails to disclose all of the features of independent claim 14, the Examiner has failed to set forth a prima facie case of anticipation of independent claim 14 by Tanoue. Appellants, therefore, request respectfully that the rejection of independent claim 14 be withdrawn.

II. The third clause of independent claim 14:

Independent claim 14 is not anticipated by Tanoue because Tanoue fails to disclose all of the features of independent claim 14. Tanoue, for example, discloses no "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as recited in the third clause of independent claim 14. Tanoue is not "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," at all, as discussed above. The

terminal device of Tanoue, rather, simply commences operation. In Tanoue, in particular, a faulty mobile device detection unit judges whether or not the mobile device is faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, as described at paragraph [0008].

Since, in Tanoue, a mobile device is judged to be faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as recited an independent claim 14.

Furthermore, in Tanoue, the *base station* controller monitors the transmission power of the outgoing signal and judges the mobile device to be faulty only if it exceeds a predetermined threshold value. In particular, as described in the Abstract:

The base station controller judges the mobile device as faulty when the transmission power of the outgoing signal exceeds the predetermined threshold value for a predetermined period of time, and registers the faulty mobile device to the mobile device managing database.

Thus, in Tanoue, unless the mobile device requests an inordinate amount of transmission power, there will be no indication that it is faulty, and operation of the mobile device will be authorized. In the claimed invention, in contrast, operation of the terminal device in the radio communication system will be authorized "only upon said terminal having received said confirmation," as recited an independent claim 14.

Furthermore, in Tanoue, the *base station* controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined level or higher. In particular, as described at paragraph [0009]:

When the transmission power of the outgoing signal continues to be at a predetermined level or higher, the base station controller judges the receiver system of the mobile device to be faulty and registers the mobile device to the mobile device managing database.

Since, in Tanoue, the base station controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined level or higher, a faulty mobile device may go undetected unless and until it draws more than a predetermined level of power. Thus, Tanoue is checking the power level of the outgoing signal,

not the functional integrity of the terminal device, let alone "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as recited an independent claim 14.

Furthermore, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time. In particular, as described at paragraph [0038]:

Then, in all the branches of the base stations NoDeB, when the outgoing transmission power reaches a certain percentage or more for a certain period of time, the base station controller RNC judges the mobile device UE to be a faulty mobile device, and transmits a faulty mobile device registration request message 32 to the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time, a faulty mobile device may go undetected unless and until it draws more than a predetermined level of power. Thus, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as recited an independent claim 14.

Finally, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list. In particular, as described at paragraph [0039]:

Upon receiving the mobile device registration request message 32 transmitted from the base station controllers RNC, the mobile device managing database DB first judges whether or not the target mobile device is registered on the faulty mobile device list in the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list, Tanoue is checking whether the target mobile device is registered on the faulty mobile device list, not "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as recited an independent claim 14.

Accordingly, because Tanoue fails to disclose all of the features of independent claim 14, the Examiner has failed to set forth a prima facie case of anticipation of independent claim 14 by Tanoue. Appellants, therefore, request respectfully that the rejection of independent claim 14 be withdrawn.

B. Independent claim 24:

I. The fourth clause of independent claim 24:

Independent claim 24 is not anticipated by Tanoue because Tanoue fails to disclose all of the features of independent claim 24. Tanoue, for example, discloses no "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," as recited in the fourth clause of independent claim 24. The terminal device of Tanoue, rather, simply commences operation. The responsibility of setting a permissible range of transmission power to be transmitted to the mobile device UE at the time of starting communication falls on the base station controller RNC in Tanoue. Setting the permissible range of transmission power is not a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0027]:

At the time of starting communication between the mobile device UE and the base station controller RNC, the base station controller RNC sets to the base station the permissible range of transmission power (the maximum transmission power, the minimum transmission power) to be transmitted to the mobile device UE.

Since, in Tanoue, the base station controller RNC only sets the permissible range of transmission power to be transmitted to the mobile device UE at the time of starting communication, Tanoue is not "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," as recited in independent claim 24.

Additionally, in Tanoue, the base station controller RNC only searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB. Searching whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0040]:

The base station controller RNC upon receiving the access request message 51 searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB based on the mobile device search information contained in the access request message 51 from the mobile device UE.

Since, in Tanoue, the base station controller RNC searches whether or not the mobile device is

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contained in the faulty mobile device information supplied from the mobile device managing database DB, Tanoue is not "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," as recited an independent claim 24.

Furthermore, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by one rank from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0043]:

As the desired quality class set for the mobile device UE, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE, Tanoue is not "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," as recited an independent claim 24.

Furthermore, in Tanoue, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by two ranks from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0045]:

As the desired quality class set for the mobile device UE, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE, Tanoue is not "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," as recited an independent claim 24.

Finally, in Tanoue, an access request from the mobile device UE is rejected. Rejecting an access request from the mobile device UE is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0047]:

An access request from the mobile device UE is rejected. That is, an access

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request rejection message is transmitted to the mobile device UE.

Since, in Tanoue, an access request from the mobile device UE is rejected, Tanoue is not "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," as recited in independent claim 24.

The Examiner asserts in section 2b at pages 2 and 3 of the final Office Action mailed March 8, 2007, that:

Tanoue teaches such claimed limitations "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation" (judge whether UE is faulty or not faulty during connecting sequence, see Pars. [0038-47, 0008 and 0010-11]); and "only permitting further operation of said terminal device if said receive device has received a confirmation signal (access is granted upon judging that UE is not faulty or the UE is normal, but access is rejected otherwise, see Pars. [0038-47 0008 and 0010-11]).

This characterization of Tanoue is also submitted to be incorrect. "Judging whether the UE is faulty or not faulty during the connecting sequence," is not equivalent to "receiving a confirmation signal indicating that the terminal device will be checked for proper functional integrity during operation," contrary to the Examiner's assertion, let alone authorizing operation of the UE *only* upon confirmation that the UE will be checked for proper functional integrity during operation. Such a check, let alone a confirmation, simply never happens in Tanoue.

In Tanoue, rather, a *base station* monitors the power required by the UE and rejects access if the UE requests too much power. The UE itself is never checked for proper functional integrity, nor is its continued operation dependent upon confirmation that it would be checked for proper functional integrity. Since, in Tanoue, a mobile device is judged to be faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, Tanoue is not "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," as recited in independent claim 24.

Accordingly, because Tanoue fails to disclose all of the features of independent claim 24, the Examiner has failed to set forth a prima facie case of anticipation of independent claim 24 by Tanoue. Appellants, therefore, request respectfully that the rejection of independent claim 24 be withdrawn.

II. The fifth clause of independent claim 24:

Independent claim 24 is not anticipated by Tanoue because Tanoue fails to disclose all of the features of independent claim 24. Tanoue, for example, discloses no "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited in the fifth clause of independent claim 24. Tanoue is not "receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation," at all, as discussed above. The terminal device of Tanoue, rather, simply commences operation. A faulty mobile device detection unit judges whether or not the mobile device is faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time. In particular, as described at paragraph [0008]:

The base station controller comprises a faulty mobile device detection unit for judging whether or not the mobile device is faulty based on the fact that the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, a faulty device registration request unit for supplying a faulty device registration request to the mobile device managing database to register a mobile device judged as faulty, and a desired receiving quality change instruction unit for giving an instruction to degrade a desired receiving quality class of a mobile device or for supplying a message to reject an access request to the mobile device in the case where, upon receiving the access request from the mobile device, the mobile device is found to be registered as faulty after searching the mobile terminal managing database.

Since, in Tanoue, a mobile device is judged to be faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 24.

Furthermore, in Tanoue, the *base station* controller monitors the transmission power of the outgoing signal and judges the mobile device to be faulty only if it exceeds a predetermined threshold value. In particular, as described in the Abstract:

The base station controller judges the mobile device as faulty when the transmission power of the outgoing signal exceeds the predetermined threshold value for a predetermined period of time, and registers the faulty mobile device to the mobile device managing database.

Thus, in Tanoue, unless the mobile device requests an inordinate amount of transmission power, there will be no indication that it is faulty, and operation of the mobile device will be authorized.

In the claimed invention, in contrast, operation of the terminal device in the radio communication system will be authorized "only upon said terminal having received said confirmation," as recited an independent claim 24.

Furthermore, in Tanoue, the *base station* controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined level or higher. In particular, as described at paragraph [0009]:

When the transmission power of the outgoing signal continues to be at a predetermined level or higher, the base station controller judges the receiver system of the mobile device to be faulty and registers the mobile device to the mobile device managing database.

Since, in Tanoue, the base station controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined level or higher, a faulty mobile device may go undetected unless and until it draws more than a predetermined level of power. Thus, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 24.

Furthermore, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time. In particular, as described at paragraph [0038]:

Then, in all the branches of the base stations NoDeB, when the outgoing transmission power reaches a certain percentage or more for a certain period of time, the base station controller RNC judges the mobile device UE to be a faulty mobile device, and transmits a faulty mobile device registration request message 32 to the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time, a faulty mobile device may go undetected unless and until it draws more than a predetermined level of power. Thus, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 24.

Finally, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list. In

particular, as described at paragraph [0039]:

Upon receiving the mobile device registration request message 32 transmitted from the base station controllers RNC, the mobile device managing database DB first judges whether or not the target mobile device is registered on the faulty mobile device list in the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list, Tanoue is checking whether the target mobile device is registered on the faulty mobile device list, not "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 24.

Accordingly, because Tanoue fails to disclose all of the features of independent claim 24, the Examiner has failed to set forth a prima facie case of anticipation of independent claim 24 by Tanoue. Appellants, therefore, request respectfully that the rejection of independent claim 24 be withdrawn.

C. Independent claim 25:

I. The second clause of independent claim 25:

Independent claim 25 is not anticipated by Tanoue because Tanoue fails to disclose all of the features of independent claim 25. Tanoue, for example, discloses no "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," as recited in the second clause of independent claim 25. The terminal device of Tanoue, rather, simply commences operation. The responsibility of setting a permissible range of transmission power to be transmitted to the mobile device UE at the time of starting communication falls on the base station controller RNC in Tanoue. Setting the permissible range of transmission power is not a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0027]:

At the time of starting communication between the mobile device UE and the base station controller RNC, the base station controller RNC sets to the base station the permissible range of transmission power (the maximum transmission power, the minimum transmission power) to be transmitted to the mobile device UE.

Since, in Tanoue, the base station controller RNC sets the permissible range of transmission

power to be transmitted to the mobile device UE at the time of starting communication, Tanoue is not "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 25.

Additionally, in Tanoue, the *base station* controller RNC searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB. Searching whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0040]:

The base station controller RNC upon receiving the access request message 51 searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB based on the mobile device search information contained in the access request message 51 from the mobile device UE.

Since, in Tanoue, the base station controller RNC searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB, Tanoue is not "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 25.

Furthermore, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by one rank from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0043]:

As the desired quality class set for the mobile device UE, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE, Tanoue is not "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 25.

Furthermore, in Tanoue, an access response message 52 degraded by two ranks from a

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regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by two ranks from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0045]:

As the desired quality class set for the mobile device UE, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE, Tanoue is not "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 25.

Finally, in Tanoue, an access request from the mobile device UE is rejected. Rejecting an access request from the mobile device UE is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0047]:

An access request from the mobile device UE is rejected. That is, an access request rejection message is transmitted to the mobile device UE.

Since, in Tanoue, an access request from the mobile device UE is rejected, Tanoue is not "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 25.

The Examiner asserts in section 2c at page 3 of the final Office Action mailed March 8, 2007, that:

Tanoue teaches such claimed limitations "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system" (judge whether UE is faulty or not faulty during connecting sequence, see Pars. [0038-47, 0008 and 0010-11]); and "only permitting further operation of said terminal device if said receive device has received a confirmation signal (access is granted upon judging that UE is not faulty or the UE is normal, but access is rejected otherwise, see Pars. [0038-47 0008 and 0010-11]).

This characterization of Tanoue is also submitted to be incorrect. "Judging whether the UE is faulty or not faulty during the connecting sequence," is not equivalent to "receiving a confirmation

signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," contrary to the Examiner's assertion, let alone authorizing operation of the UE *only* upon confirmation that the UE will be checked for proper functional integrity during operation. Such a check, let alone a confirmation, simply never happens in Tanoue.

In Tanoue, rather, a *base station* monitors the power required by the UE and rejects access if the UE requests too much power. The UE itself is never checked for proper functional integrity, nor is its continued operation dependent upon confirmation that it would be checked for proper functional integrity. Since, in Tanoue, a mobile device is judged to be faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, Tanoue is not "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," as recited in independent claim 25.

Accordingly, because Tanoue fails to disclose all of the features of independent claim 25, the Examiner has failed to set forth a prima facie case of anticipation of independent claim 25 by Tanoue. Appellants, therefore, request respectfully that the rejection of independent claim 25 be withdrawn.

II. The third clause of independent claim 25:

Independent claim 25 is not anticipated by Tanoue because Tanoue fails to disclose all of the features of independent claim 25. Tanoue, for example, discloses no "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited in the third clause of independent claim 25. Tanoue is not "receiving a confirmation signal from the confirmation unit of the communications system, indicating that said terminal device will be checked for proper functional integrity during operation in the communications system," at all, as discussed above. The terminal device of Tanoue, rather, simply commences operation. A faulty mobile device detection unit judges whether or not the mobile device is faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time. In particular, as described at paragraph [0008]:

The base station controller comprises a faulty mobile device detection unit for judging whether or not the mobile device is faulty based on the fact that the

transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, a faulty device registration request unit for supplying a faulty device registration request to the mobile device managing database to register a mobile device judged as faulty, and a desired receiving quality change instruction unit for giving an instruction to degrade a desired receiving quality class of a mobile device or for supplying a message to reject an access request to the mobile device in the case where, upon receiving the access request from the mobile device, the mobile device is found to be registered as faulty after searching the mobile terminal managing database.

Since, in Tanoue, a mobile device is judged to be faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 25.

Furthermore, in Tanoue, the base station controller monitors the transmission power of the outgoing signal and judges the mobile device to be faulty *only* if it exceeds a predetermined threshold value. In particular, as described in the Abstract:

The base station controller judges the mobile device as faulty when the transmission power of the outgoing signal exceeds the predetermined threshold value for a predetermined period of time, and registers the faulty mobile device to the mobile device managing database.

Thus, in Tanoue, unless the mobile device requests an inordinate amount of transmission power, there will be no indication that it is faulty, and operation of the mobile device will be authorized. In the claimed invention, in contrast, operation of the terminal device in the radio communication system will be authorized "only upon said terminal having received said confirmation," as recited an independent claim 25.

Furthermore, in Tanoue, the base station controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined level or higher. In particular, as described at paragraph [0009]:

When the transmission power of the outgoing signal continues to be at a predetermined level or higher, the base station controller judges the receiver system of the mobile device to be faulty and registers the mobile device to the mobile device managing database.

Since, in Tanoue, the base station controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined

level or higher, a faulty mobile device may go undetected unless and until it draws more than a predetermined level of power. Thus, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 25.

Furthermore, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time. In particular, as described at paragraph [0038]:

Then, in all the branches of the base stations NoDeB, when the outgoing transmission power reaches a certain percentage or more for a certain period of time, the base station controller RNC judges the mobile device UE to be a faulty mobile device, and transmits a faulty mobile device registration request message 32 to the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time, a faulty mobile device may go undetected unless and until it draws more than a predetermined level of power. Thus, Tanoue is checking the power level of the outgoing signal, not the functional integrity of the terminal device, let alone "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 25.

Finally, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list. In particular, as described at paragraph [0039]:

Upon receiving the mobile device registration request message 32 transmitted from the base station controllers RNC, the mobile device managing database DB first judges whether or not the target mobile device is registered on the faulty mobile device list in the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list, Tanoue is checking whether the target mobile device is registered on the faulty mobile device list, not "only permitting further operation of said terminal device if said receive device has received of the confirmation signal," as recited an independent claim 25.

Accordingly, because Tanoue fails to disclose all of the features of independent claim 25, the Examiner has failed to set forth a prima facie case of anticipation of independent claim 25 by

Tanoue. Appellants, therefore, request respectfully that the rejection of independent claim 25 be withdrawn.

D. Independent claim 26:

Independent claim 26 is not anticipated by Tanoue because Tanoue fails to disclose all of the features of independent claim 26. Tanoue, for example, discloses no "generating a confirmation signal, from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited in the second clause of independent claim 26. The terminal device of Tanoue, rather, simply commences operation. The responsibility of setting a permissible range of transmission power to be transmitted to the mobile device UE at the time of starting communication falls on the base station controller RNC in Tanoue. Setting the permissible range of transmission power is not a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0027]:

At the time of starting communication between the mobile device UE and the base station controller RNC, the base station controller RNC sets to the base station the permissible range of transmission power (the maximum transmission power, the minimum transmission power) to be transmitted to the mobile device UE.

Since, in Tanoue, the base station controller RNC sets the permissible range of transmission power to be transmitted to the mobile device UE at the time of starting communication, Tanoue is not "generating a confirmation signal, from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Additionally, in Tanoue, the *base station* controller RNC searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB. Searching whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0040]:

The base station controller RNC upon receiving the access request message 51 searches whether or not the mobile device is contained in the faulty mobile device information supplied from the mobile device managing database DB based on the mobile device search information contained in the access request message 51 from the mobile device UE.

Since, in Tanoue, the base station controller RNC searches whether or not the mobile device is

contained in the faulty mobile device information supplied from the mobile device managing database DB, Tanoue is not "generating a confirmation signal, from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Furthermore, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by one rank from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0043]:

As the desired quality class set for the mobile device UE, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by one rank from a regular set value is transmitted to the mobile device UE, Tanoue is not "generating a confirmation signal, from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Furthermore, in Tanoue, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE. Transmitting an access response message 52 degraded by two ranks from a regular set value is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described in Tanoue at paragraph [0045]:

As the desired quality class set for the mobile device UE, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE.

Since, in Tanoue, an access response message 52 degraded by two ranks from a regular set value is transmitted to the mobile device UE, Tanoue is not "generating a confirmation signal, from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Finally, in Tanoue, an access request from the mobile device UE is rejected. Rejecting an access request from the mobile device UE is not sending a confirmation that the mobile device will be checked for proper functional integrity during operation. In particular, as described

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in Tanoue at paragraph [0047]:

An access request from the mobile device UE is rejected. That is, an access request rejection message is transmitted to the mobile device UE.

Since, in Tanoue, an access request from the mobile device UE is rejected, Tanoue is not "generating a confirmation signal from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

The Examiner asserts in section 2d at page 4 of the final Office Action mailed March 8, 2007, that:

Tanoue teaches such claimed limitations (judging whether UE is faulty or not faulty during connecting sequence and an access is given accordingly, see Pars. [0038-47 and 0011]).

This characterization of Tanoue is also submitted to be incorrect. "Judging whether the UE is faulty or not faulty during the connecting sequence," is not equivalent to "generating a confirmation signal, from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," contrary to the Examiner's assertion, let alone authorizing operation of the UE *only* upon confirmation that the UE will be checked for proper functional integrity during operation. Such a check, let alone a confirmation, simply never happens in Tanoue.

In Tanoue, rather, a base station monitors the power required by the UE and rejects access if the UE requests too much power. The UE itself is never checked for proper functional integrity, nor is its continued operation dependent upon confirmation that it would be checked for proper functional integrity.

The terminal device of Tanoue, rather, simply commences operation. A faulty mobile device detection unit judges whether or not the mobile device is faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time. In particular, as described at paragraph [0008]:

The base station controller comprises a faulty mobile device detection unit for judging whether or not the mobile device is faulty based on the fact that the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, a faulty device registration request unit for supplying a faulty device registration request to the mobile device managing database to register a

mobile device judged as faulty, and a desired receiving quality change instruction unit for giving an instruction to degrade a desired receiving quality class of a mobile device or for supplying a message to reject an access request to the mobile device in the case where, upon receiving the access request from the mobile device, the mobile device is found to be registered as faulty after searching the mobile terminal managing database.

Since, in Tanoue, a mobile device is judged to be faulty if the transmission power of the outgoing signal transmitted from the base station to the mobile device exceeds the predetermined threshold value for a predetermined period of time, Tanoue is not "generating a confirmation signal from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Furthermore, in Tanoue, the *base station* controller monitors the transmission power of the outgoing signal and judges the mobile device to be faulty only if it exceeds a predetermined threshold value. In particular, as described in the Abstract:

The base station controller judges the mobile device as faulty when the transmission power of the outgoing signal exceeds the predetermined threshold value for a predetermined period of time, and registers the faulty mobile device to the mobile device managing database.

Since, in Tanoue, the base station controller monitors the transmission power of the outgoing signal and judges the mobile device to be faulty only if it exceeds a predetermined threshold value, Tanoue is not "generating a confirmation signal from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Furthermore, in Tanoue, the *base station* controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined level or higher. In particular, as described at paragraph [0009]:

When the transmission power of the outgoing signal continues to be at a predetermined level or higher, the base station controller judges the receiver system of the mobile device to be faulty and registers the mobile device to the mobile device managing database.

Since, in Tanoue, the base station controller judges the receiver system of the mobile device to be faulty if the transmission power of the outgoing signal continues to be at a predetermined level or higher, Tanoue is not "generating a confirmation signal from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in

the communications system," as recited an independent claim 26.

Furthermore, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time. In particular, as described at paragraph [0038]:

Then, in all the branches of the base stations NoDeB, when the outgoing transmission power reaches a certain percentage or more for a certain period of time, the base station controller RNC judges the mobile device UE to be a faulty mobile device, and transmits a faulty mobile device registration request message 32 to the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the outgoing transmission power reaches a certain percentage or more for a certain period of time, Tanoue is not "generating a confirmation signal from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Finally, in Tanoue, the *base station* controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list. In particular, as described at paragraph [0039]:

Upon receiving the mobile device registration request message 32 transmitted from the base station controllers RNC, the mobile device managing database DB first judges whether or not the target mobile device is registered on the faulty mobile device list in the mobile device managing database DB.

Since, in Tanoue, the base station controller RNC judges the mobile device UE to be a faulty mobile device if the target mobile device is registered on the faulty mobile device list, , Tanoue is not "generating a confirmation signal from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communications system," as recited an independent claim 26.

Accordingly, because Tanoue fails to disclose all of the features of independent claim 26, the Examiner has failed to set forth a prima facie case of anticipation of independent claim 26 by Tanoue. Appellants, therefore, request respectfully that the rejection of independent claim 26 be withdrawn.

3. Dependent claims 15 and 16 are patentable over Tanoue in view of Leung.

First, dependent claims 15 and 16 are patentable over Tanoue in view of Leung because neither Tanoue nor Leung, nor their combination, disclose all of the features of dependent claims

15 and 16.

Dependent claims 15 and 16 depend from independent claim 14 and add further distinguishing elements. Tanoue discloses neither "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," nor "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above with respect to the rejection of independent claim 14. Leung does not either, and thus cannot make up for the deficiencies of Tanoue with respect to dependent claims 15 and 16. Thus, even if Tanoue and Leung were combined, as proposed by the Examiner, the claimed invention would not result.

Accordingly, because neither Tanoue nor Leung, nor their combination, disclose all of the features of dependent claims 15 and 16, the Examiner has failed to set forth a prima facie case of obviousness of dependent claims 15 and 16 by Tanoue in view of Leung. Appellants, therefore, request respectfully that the rejection of dependent claims 15 and 16 be withdrawn.

Second, dependent claims 15 and 16 are patentable over Tanoue in view of Leung because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue in view of Leung proposed by the Examiner.

The test for obviousness under 35 U.S.C. § 103 (a) is set forth by the United States Supreme Court in *Graham v. John Deere, Co.*, 383 U.S. 1, 17-18 (1966). As mandated therein, in an obviousness determination under 35 U.S.C. § 103, the scope and content of the prior art are to be determined, the differences between the prior art and the claims at issue are to be ascertained and the level of ordinary skill in the pertinent art resolved.

There is no disclosure in either Tanoue or Leung of "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," or "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above. Thus, even if Tanoue and Leung were combined, as proposed by the Examiner, dependent claims 15 and 16 would not result. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would not have combined Tanoue and Leung, as proposed by the Examiner, since the combination would not compensate for the deficiencies of Tanoue with respect to dependent claims 15 and 16 in any case.

Accordingly, because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue in view of Leung proposed by the Examiner,

dependent claims 15 and 16 are patentable over Tanoue in view of Leung. Appellants, therefore, request respectfully that the rejection of dependent claims 15 and 16 be withdrawn.

4. Dependent claim 17 is patentable over Tanoue in view of Flykt.

First, dependent claim 17 is patentable over Tanoue and Leung in view of in view of Flykt because neither Tanoue, Leung, nor Flykt, nor their combination, disclose all of the features of dependent claim 17.

Dependent claim 17 depends from independent claim 14 and adds further distinguishing elements. Neither Tanoue nor Leung are "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," or "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above with respect to the rejection of dependent claims 15 and 16. Flykt does not either, and thus cannot make up for the deficiencies of either Tanoue or Leung with respect to dependent claim 17. Thus, even if Tanoue, Leung, and Flykt were combined, as proposed by the Examiner, the claimed invention would not result.

Accordingly, because neither Tanoue, Leung, nor Flykt, nor their combination, disclose all of the features of dependent claim 17, the Examiner has failed to set forth a prima facie case of obviousness of dependent claim 17 by Tanoue and Leung in view of Flykt. Appellants, therefore, request respectfully that the rejection of dependent claim 17 be withdrawn.

Second, dependent claim 17 is patentable over Tanoue and Leung in view of Flykt because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue and Leung in view of Flykt proposed by the Examiner.

There is no disclosure in either Tanoue, Leung, or Flykt of "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," or "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above. Thus, even if Tanoue, Leung, and Flykt were combined, as proposed by the Examiner, dependent claim 17 would not result. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would not have combined Tanoue, Leung, and Flykt, as proposed by the Examiner, since the combination would not compensate for the deficiencies of either Tanoue or Leung with respect to dependent claim 17 in any case.

Accordingly, because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue and Leung in view of Flykt proposed by the Examiner, dependent claim 17 is patentable over Tanoue and Leung in view of Flykt. Appellants, therefore, request respectfully that the rejection of dependent claim 17 be withdrawn.

5. Dependent claims 18 and 19 are patentable over Tanoue, Leung, and Flykt in view of Namba.

First, dependent claims 18 and 19 are patentable over Tanoue, Leung, and Flykt in view of Namba because neither Tanoue, Leung, Flykt nor Namba, nor their combination, disclose all of the features of dependent claims 18 and 19.

Dependent claims 18 and 19 depend from independent claim 14 and add further distinguishing elements. Neither Tanoue, Leung, nor Flykt are "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," or "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above with respect to the rejection of dependent claim 17. Namba does not either, and thus cannot make up for the deficiencies of either Tanoue, Leung, or Flykt with respect to dependent claims 18 and 19. Thus, even if Tanoue, Leung, Flykt, and Namba were combined, as proposed by the Examiner, dependent claims 18 and 19 would not result.

Accordingly, because neither Tanoue, Leung, Flykt nor Namba, nor their combination, disclose all of the features of dependent claims 18 and 19, the Examiner has failed to set forth a prima facie case of obviousness of dependent claims 18 and 19 by Tanoue, Leung, and Flykt in view of Namba. Appellants, therefore, request respectfully that the rejection of dependent claims 18 and 19 be withdrawn.

Second, dependent claims 18 and 19 are patentable over Tanoue, Leung, and Flykt in view of Namba because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue, Leung, and Flykt in view of Namba proposed by the Examiner.

There is no disclosure in either Tanoue, Leung, Flykt, or Namba of "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," or "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above. Thus, even if Tanoue, Leung, Flykt, and Namba were combined, as proposed

by the Examiner, dependent claims 18 and 19 would not result. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would not have been motivated to combine Tanoue, Leung, Flykt, and Namba as proposed by the Examiner, since the combination would not compensate for the deficiencies of either Tanoue, Leung, Flykt, or Namba with respect to dependent claims 18 and 19.

Accordingly, because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue, Leung, and Flykt in view of Namba proposed by the Examiner, dependent claims 18 and 19 are patentable over Tanoue, Leung, and Flykt in view of Namba. Appellants, therefore, request respectfully that the rejection of dependent claims 18 and 19 be withdrawn.

6. Dependent claims 20-23 are patentable over Tanoue, Leung, and Flykt in view of Namba.

First, dependent claims 20-23 are patentable over Tanoue, Leung, Flykt, and Namba in view of Letsinger because neither Tanoue, Leung, Flykt, Namba, nor Letsinger, nor their combination, disclose all of the features of dependent claims 20-23.

Dependent claims 20-23 depend from independent claim 14 and add further distinguishing elements. Neither Tanoue, Leung, Flykt, nor Namba are "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," or "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above with respect to the rejection of dependent claims 18 and 19. Letsinger does not either, and thus cannot make up for the deficiencies of either Tanoue, Leung, Flykt, or Namba with respect to dependent claims 20-23. Thus, even if Tanoue, Leung, Flykt, Namba, and Letsinger were combined, as proposed by the Examiner, dependent claims 20-23 would not result.

Accordingly, because neither Tanoue, Leung, Flykt, Namba, nor Letsinger, nor their combination, disclose all of the features of dependent claims 20-23, the Examiner has failed to set forth a prima facie case of obviousness of dependent claims 20-23 by Tanoue, Leung, Flykt, and Namba in view of Letsinger. Appellants, therefore, request respectfully that the rejection of dependent claims 20-23 be withdrawn.

Second, dependent claims 20-23 are patentable over Tanoue, Leung, Flykt, and Namba in view of Letsinger because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue, Leung, Flykt, and Namba in view of Letsinger proposed by the Examiner.

There is no disclosure in either Tanoue, Leung, Flykt, Namba, or Letsinger of "sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation," or "authorizing operation of the terminal device in the radio communication system only upon said terminal having received said confirmation," as discussed above. Thus, even if Tanoue, Leung, Flykt, Namba, and Letsinger were combined, as proposed by the Examiner, dependent claims 20-23 would not result. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would not have been motivated to combine Tanoue, Leung, Flykt, Namba, and Letsinger as proposed by the Examiner, since the combination would not compensate for the deficiencies of either Tanoue, Leung, Flykt, Namba, or Letsinger with respect to dependent claims 20-23.

Accordingly, because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Tanoue, Leung, Flykt, and Namba in view of Letsinger proposed by the Examiner, dependent claims 20-23 are patentable over Tanoue, Leung, Flykt, and Namba in view of Letsinger. Appellants, therefore, request respectfully that the rejection of dependent claims 20-23 be withdrawn.

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**CONTINGENT AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT AND CONTINGENT
PETITION FOR EXTENSION OF TIME**

Unless a check for the present Brief on Appeal is submitted herewith for the fee required under 37 C.F.R. § 41.20(b)(2), please charge said fee to Deposit Account No. 19-3935.

Appellants hereby petition for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-3935.

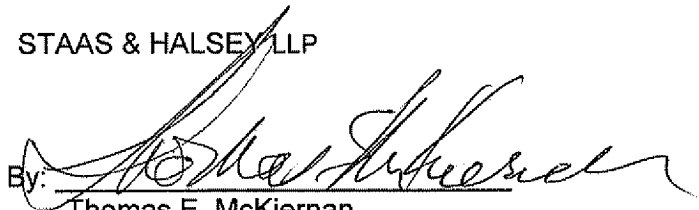
Respectfully submitted,

STAAS & HALSEY LLP

Date:

18 JUN 07

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VIII. CLAIMS APPENDIX

14. (previously presented) A method for operating a terminal device in a radio communication system, comprising:

 sending a confirmation from a confirmation unit confirming that the terminal device will be checked for proper functional integrity during operation by checking signals to be transferred via said terminal device for compliance with a least one quality criterion; and

 authorizing operation of the terminal device in the radio communication system only upon said terminal device having received said confirmation.

15. (previously presented) The method according to claim 14,
 wherein said authorizing operation of the terminal device in the communication system includes sending a confirmation signal to the terminal device, and

 wherein said method further comprises responding to receipt of the confirmation signal by the terminal device being checked during operation.

16. (previously presented) The method according to claim 15,
 further comprising:

 sending a request signal from the terminal device to a confirmation unit prior to said authorizing operation of the terminal device in the communication system, and

 initiating checking of the terminal device by the confirmation unit in response to the request signal, and

 wherein said sending of the confirmation signal to the terminal device is performed by the confirmation unit after said checking.

17. (previously presented) The method according to claim 16,
 further comprising previously storing an address of the confirmation unit in the terminal device and in a large number of terminal devices at least in the communication system, and

 wherein said sending the request signal to the confirmation unit includes the terminal device using the address of the confirmation unit stored previously in the terminal device.

18. (previously presented) The method according to claim 17,
 further comprising registering the terminal device with the communication network, and
 wherein said sending of the request signal by the terminal device only occurs after a

predefined period of time has elapsed following said registering and the terminal device has not automatically received the confirmation signal.

19. (previously presented) The method according to claim 18, wherein a plurality of devices are capable of performing said checking of the terminal device for proper functional integrity during operation, and

wherein said method further comprises determining, prior to said checking, which of the devices is performing said checking of the terminal device.

20. (previously presented) The method according to claim 19, wherein said determining of which device is performing said checking includes locating one of the devices in closest possible proximity to the terminal device.

21. (previously presented) The method according to claim 20, wherein the terminal device performs said checking, and

wherein said method further comprises delivering software needed for performing said checking to the terminal device via a wireless interface.

22. (previously presented) The method according to claim 21, wherein said checking of the terminal device, includes checking signals to be transferred by the terminal device for compliance with at least one quality criterion having value dependent on where the terminal device is situated within the radio communication system.

23. (previously presented) The method according to claim 22, further comprising refusing operation of the terminal device in the communication system after said authorizing of the terminal device for operation only if said checking of the terminal device has yielded one of a predetermined number of errors and an error exceeding a threshold value.

24. (previously presented) A radio communication system, comprising:
a confirmation unit, including

a signal generation device generating a confirmation signal; and

a transmit device sending the confirmation signal; and

a terminal device, including

a receive device receiving the confirmation signal indicating that said terminal device will be checked for proper functional integrity during operation; and

a deactivation unit only permitting further operation of said terminal device if said receive device has received the confirmation signal.

25. (previously presented) A terminal device for a radio communication system having a confirmation unit, comprising:

a receive device receiving a confirmation signal from the confirmation unit of the communication system, indicating that that said terminal device will be checked for proper functional integrity during operation in the communication system; and

a deactivation device only permitting further operation of said terminal device if said receive device has received the confirmation signal.

26. (previously presented) A confirmation unit for a radio communication system having at least one terminal device, comprising:

a device generating a confirmation signal, from which it can be inferred that the at least one terminal device will be checked for proper functional integrity during operation in the communication system; and

a transmit device sending the confirmation signal to the terminal device.

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IX. EVIDENCE APPENDIX

None.

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X. RELATED PROCEEDINGS APPENDIX

None.